

## **Remarks**

### **Drawing Amendment**

A replacement sheet for figure 8 is enclosed. In figure 8, reference numbers 70A, 70B, 70C and 70D have been added to indicate the ends and extensions of the ground plane. No new matter has been added. Support for this is found in figure 8 as originally filed.

### **Specification Amendment**

The specification has been amended to include reference numbers 70A, 70B, 70C and 70D on figure 8. Support for this is found in original figure 8 as filed.

### **Drawing Objections**

The drawings were objected to under 37 CFR 1.83a. The subject matter of claim 28 was objected to as not being shown in the drawings. Claims 28-33 have been canceled. Withdrawal of the drawing objection is respectfully requested.

### **Rejection under 35 USC 112**

Claims 28-33 were rejected under 35 USC 112 as being unclear. Claims 28-33 have been canceled. Withdrawal of the 112 rejection is respectfully requested.

### **Rejection under 35 USC 103**

Claims 28-33 were rejected under 35 USC 103a over Nakajima (JP 08-046469).

Claims 28-33 were rejected under 35 USC 103a over Koga (JP '068). Claims 28-33 have been canceled.

Claims 23-27 were rejected under 35 USC 103a over Nakajima (JP 07-288441) in view of Nosaka (U.S. patent publication 2002/0030563).

Nakajima discloses a laminated LC low pass filter and characteristic adjusting method for the same. Nosaka discloses a multi-layered LC composite component and method for adjusting frequency of the same.

Neither Nakajima nor Nosaka teach, disclose or suggest, either alone or in combination, as in amended claim 23, three ceramic dielectric layers forming a block, a pair of metal plates located between the first and second ceramic dielectric layers and a ground plane. The ground plane is located within the block between the second and third ceramic layers. The first metal plate, the second ceramic dielectric layer and the ground plane form a first capacitor. The second metal plate, the second ceramic dielectric layer and the ground plane form a second capacitor. The metal plates overlap ends of the ground plane.

### **The present invention as claimed is different than the combination of the cited references**

Nakajima discloses six layers, not three as claimed in the present invention. Nosaka discloses six layers. If the combination of Nakajima and Nosaka were made, the combination would require six layers.

The addition of three extra layers would result in a large change in the inductance and capacitance values of the filter and severely change the electrical performance of the device. In addition, six layers would add additional cost and complexity to the device and would be undesirable.

Amended claim 23 recites that the first and second terminals cover the first, second and third layers.

If the combination of Nakajima and Nosaka were made, the combination would require that the terminals cover six layers.

#### **The combination of the cited references results in an inoperable device**

Nosaka discloses in paragraph 26 that the ground electrode 3 may be disposed on the entire top surface of the dielectric sheet. If the conductor pattern 15 of Nakajima was extended in accordance with the teachings of Nosaka, across the entire top surface, the conductor pattern 15 would extend to terminals 17 and form a short circuit between terminals 17 and earth terminal 18 and render the filter inoperable.

The Federal Circuit has set forth that when a proposed combination is inoperable that this teaches away from the combination and supports the showing that the invention is novel and non-obvious. Tec Air Inc. v. Denso Manufacturing Mighigan Inc., 192 F.3d 1353, 52 USPQ2d 1294 (Federal Circuit 1999).

In contrast, Applicant's invention solves the problems of the prior art devices and results in a filter having fewer layers with improved isolation.

#### **The combination of the cited references is not obvious**

As the court of Appeals, Federal Circuit has set forth, even if prior art references could be combined to construct an applicants invention, the modification is not obvious unless there is a suggestion in the prior art. In re Laskowski, 10 USPQ2d 1397 1398 (Fed. Cir. 1989). Applicant respectfully submits that there is no suggestion in either Nakajima or Nosaka to modify Nakajima to include a ground plane that overlaps the first and second portions. Further there is no suggestion in either Nakajima or Nosaka to use ceramic materials for the layers and that the claims are patentably distinguishable over the art of record.

**The combination of the cited references can only be gleaned through hindsight reasoning.**

There is no basis for making the suggested combination. There must be a showing of some objective teaching in the prior art or that knowledge generally available to one of ordinary in the skill of the art would lead that individual to combine the relevant teachings of the references. *In Re Fine*, 837 F2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed Cir 1988) (citing *In Re Lulu*, 747 F2d 703, 705, 223 USPQ 1257, 1258 (Fed Cir 1988)). A rejection based on §103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, there is an initial burden of supplying the factual basis for the rejection advanced. One may not, because of doubt that the invention is patentable, resort to speculation, unfound assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). The cited combination of Nakajima and Nosaka can only be arrived at

after reading Applicant's present specification.

### **Request for Affidavit under 37 CFR 1.107b**

On page 8, line 8 of the office action it is recited that the use of ceramic material is well known in the art. No references are cited. Applicants respectfully request an affidavit under 37 CFR 1.107b in support of the examiner's statement of the use of ceramic material being well known in the art.

### **Dependent claims**

Dependent claims 24, 26 and 27 depend from independent claim 23, respectively and add additional patentable features and are allowable therewith.

### **Conclusion**

In view of the current amendments and remarks, the claims are now believed to be in condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kevin Redmond". The signature is written in a cursive, flowing style with a large initial "K".

Kevin Redmond  
Reg. No. 27,049

**Amendments to the Drawings:**

The attached sheet of drawings includes changes to figure 8. This sheet replaces the original sheet containing figures 7 and 8.

Attachment: Replacement Sheet.